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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91179298
Party	Plaintiff Walgreen Co.
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Submission	Motion to Amend Pleading/Amended Pleading
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Attachments	Motion For Leave To Amend Notice Of Opposition.pdf (10 pages)(321278 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

WALGREEN CO.,)
Opposer,)
) Serial No. 77/179411
v.)
) Opposition No. 91179298
SYLMARK HOLDINGS LIMITED,)
Applicant.)

OPPOSER'S MOTION FOR LEAVE TO
AMEND NOTICE OF OPPOSITION

Opposer Walgreen Co., by its attorneys and pursuant to the Trademark Trial and Appeal Board Manual of Procedure Rule 507, the Federal Rules of Civil Procedure Rule 15(a), and 37 C.F.R. § 2.107, moves for leave to file an Amended Notice of Opposition. In support thereof, Opposer states as follows.

Opposer's Notice of Opposition claimed that Applicant is not entitled to registration of the mark CALGREENS due to a likelihood of confusion with Opposer's mark WALGREENS. In the alternative, Opposer claimed that registration of Applicant's CALGREENS mark would cause dilution of the distinctive quality of Opposer's WALGREENS mark. Applicant Sylmark has Answered Opposer's Notice of Opposition and the parties have moved into discovery.

The application opposed herein was filed under Section 1(b) of the Trademark Act and based on Applicant's alleged bona fide intent to use the mark. However, during the course of this proceeding, Applicant has answered certain discovery requests and according to Applicant's responses to same, it appears that Applicant has not now or ever identified any products intended for sale under the mark, has not identified any intended date of first use of the mark, expected channels of trade for products bearing Applicant's mark, methods of advertising Applicant's mark, target markets or consumers of any goods allegedly to bear the CALGREENS mark. In

short, Applicant evidently has no plans whatsoever to bring any products to market under the CALGREENS mark at any time and it likely never did—as requests for historical information were responded to in the negative.

Under Section 1(b) of the Trademark Act, “[a] person who has a bona fide intention, under circumstances showing the good faith of such person, to use a trademark in commerce may request registration of its trademark on the principal register.” 15 U.S.C. § 1051(b). The question of whether an applicant has “bona fide” intent to use a mark is an objective standard. Absence of a bona fide intent to use a mark undermines the intent and purpose of Section 1(b) and where an applicant does not have this bona fide intent to use a mark, it is improper to seek registration under Section 1(b). *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha Opposition*, 26 U.S.P.Q.2d 1503, 1506 (T.T.A.B. 1993). The Board has held that the absence of documentary evidence of an applicant’s intent to use its mark in commerce without adequate explanation “is sufficient to prove that the applicant lacks a bona fide intention to use its mark in commerce” under 15 U.S.C. § 1051(b). *See also Commodore*, 26 U.S.P.Q.2d at 1507.

In the instant matter, based on Applicant’s disclosures to date, the absence of any plans or information concerning any products to be sold under the mark opposed and any information, plans, studies or the like concerning such things as intended markets, target consumers, channels of trade, marketing and advertising of goods bearing the mark, it does not appear Applicant has a bona fide intent to use the CALGREENS mark. Accordingly, Opposer moves the Board for leave to Amend its Notice of Opposition to add a claim relating to same. and the absence of any plans, the evidence learned through discovery to date, it ought to be allowed to amend its opposition to include a claim that Applicant does not in fact have a bona fide intent to use its mark in commerce. Indeed, it is entirely proper for a party to amend its notice of opposition to

allege an absence of bona fide intent to use a mark based on information like this learned in discovery. *Commodore, supra*.

After a responsive pleading has been made, "a party may amend the party's pleading only by leave of court . . . and leave shall be freely given when justice so requires." Fed. R. Civ. Pro. R. 15(a). Typically, "the Board liberally grants leave to amend pleadings at any stage of a proceeding when justice so requires. . . ." TBMP § 507.02. In the case at bar, facts obtained during discovery support the additional basis against registration of the CALGREENS application that Opposer seeks to assert. Further, given the requirement that Section 1(b) applications be supported by a bona fide intent to use justice requires amendment of the Notice of Opposition to prohibit Applicant from seeking registration without any actual intent to use the mark. Accordingly, Opposer respectfully requests the Board grant it leave to amend its Notice of Opposition to include this additional claim. A proposed Amended Notice of Opposition is attached hereto as Exhibit A.

Respectfully submitted,

Date: 1-9-08

By: 

Mark J. Liss

Mark A. Niede

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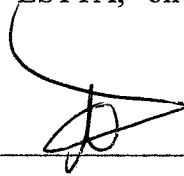
Fax: (312) 616-5600

Attorneys for Opposer

CERTIFICATE OF ELECTRONIC FILING

I hereby certify that a copy of the attached Opposer's Motion For Leave To Amend Notice Of Opposition was electronically filed with the Trademark Trial and Appeal Board's Electronic System for Trademark Trials and Appeals, "ESTTA," on the date shown below:

Dated: January 9, 2008

A handwritten signature in black ink, consisting of a stylized 'J' or 'D' shape with a long horizontal stroke extending to the right, positioned above a horizontal line.

CERTIFICATE OF SERVICE

I hereby certify that a copy of the attached Opposer's Motion For Leave To Amend Notice Of Opposition was served on counsel for Applicant via United States Postal Service First Class Mail, postage prepaid, on the date indicated below to the following address:

Bruce G. Chapman
Connolly Bove Lodge & Hutz LLP
Wells Fargo Center
South Tower, Suite 2300
333 South Grand Avenue
Los Angeles, CA 90071

Dated: January 9, 2008

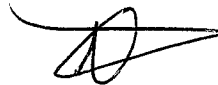
A handwritten signature in black ink, consisting of a stylized 'J' or 'D' shape with a long horizontal stroke extending to the right, positioned above a horizontal line.

EXHIBIT A

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

WALGREEN CO.,)	
)	
Opposer,)	
)	Serial No. 77/179411
v.)	
)	Opposition No.
SYLMARK HOLDINGS LIMITED)	
)	
Applicant.)	

OPPOSER'S FIRST AMENDED NOTICE OF OPPOSITION

In the matter of Application Serial No. 77/179411 for registration of the mark CALGREENS in International Class 5 by Sylmark Holdings Limited, an Irish Corporation, which application was published in the Official Gazette on August 21, 2007, Walgreen Co., an Illinois corporation, located and doing business at 200 Wilmot Road, Deerfield, Illinois 60015 (hereinafter referred to as "Opposer"), believes it will be damaged by registration of this mark and therefore opposes the same.

As grounds for the opposition, Opposer alleges as follows:

1. Applicant seeks to register the mark CALGREENS on the Principal Register for "nutritional supplements" in Class 5 as evidenced by the publication of the mark in the August 21, 2007 issue of the Official Gazette.
2. Opposer adopted and has continuously been using the mark WALGREENS in commerce since at least as early as December 1900 for pharmacy and retail store services and owns United States Reg. No. 2096551, registered September 16, 1997, for said mark. As further identified in that Registration, Opposer has adopted and continuously used the WALGREENS mark since 1974 on a number of other products,

including such diverse items as acne medications, allergy medicines, antiseptics, antacids, antihistamines, cold capsules, cough drops, day and night cold medicine, decongestant tablets, diarrhea medications, laxatives, lip balms, mouthwash, multi-antibiotic cream, pain relievers, namely, aspirin and non aspirin, sinus tablets, sore throat lozenges, vitamin supplements, zinc oxide, aftershave, skin moisturizers, baby oil, baby powder, baby shampoo, bath powder, bath oils, deodorant and antiperspirant, hair gels, shampoo and spray, shaving creams and lotions, skin creme, skin lotions, skin moisturizers, suntan lotion, and toothpaste. Opposer also owns United States Reg. No. 2876500 for the mark WALGREENS and Design; United States Reg. No. 2876500 for retail pharmacy, retail drug store and general merchandise store services and United States Reg. No. 2292545 for retail pharmacy, retail drug store and general merchandise store services, among others.

3. Opposer's goods and services offered under the WALGREENS mark, including such items as those listed above and including vitamin supplements, are and have been extensively advertised and promoted throughout the United States. Opposer has spent significant sums to advertise and promote its goods and services under its WALGREENS mark, and there is substantial goodwill associated with this mark. Opposers' longstanding use of the WALGREENS mark, together with its substantial sales and extensive advertising efforts associated with the mark, have served to make the mark famous among relevant consumers.

4. The mark WALGREENS has come to be widely known, recognized, and respected among the public and in the business community as indicating goods originating exclusively from Opposer.

5. Applicant's CALGREENS mark is virtually identical to Opposer's WALGREENS mark.
6. Applicant's mark identifies nutritional supplements in Class 5, goods which are virtually identical to—if not directly competitive to—the vitamin supplements identified in Opposer's Registration Number 2096551.
7. As a retail pharmacy, drug store and general merchandiser, Opposer regularly sells nutritional supplements, thus there is an overlap of consumers who are likely to be confused as to the source of Applicant's goods.
8. Applicant's nutritional supplements will likely be directed to consumers familiar with Opposers' WALGREENS mark and its goods and services, including vitamin supplements and other such related and competitive goods, causing consumer confusion as to the source of Applicant's goods.
9. Due to the confusing similarity of the parties' respective marks, the virtual identity of the parties' goods and the overlapping of relevant consumers, confusion is likely.
10. If Applicant obtains a registration for the subject mark, Opposer is likely to be damaged in that the *prima facie* effect of such registration will tend to cause confusion and thus impair Opposer's rights to use its WALGREENS mark in connection with its goods.
11. By reason of all the foregoing, Opposer will be significantly damaged by the registration of the Applicant's mark.

12. In the alternative, Applicant has no bona fide intent to use the mark in commerce as required by Section 1(b) of the Trademark Act and to support its Intent to Use application to register the CALGREENS mark.

13. In the alternative, due to the similar nature of Applicant's proposed CALGREENS mark and Opposer's distinctive and famous WALGREENS mark, registration of Applicant's mark would cause dilution of the distinctive quality of Opposer's WALGREENS mark and, therefore, registration should be refused pursuant to the Anti-Dilution statute, 15. U.S.C. 1052(c).

14. In view of the above, Applicant is not entitled to federal registration of the mark CALGREENS, Serial No. 77/179411.

WHEREFORE, Walgreen Co., by its attorneys, respectfully requests that the Notice of Opposition be sustained and that registration of the mark CALGREENS, Serial No. 77/179411, be refused.

Respectfully submitted,

Date: _____

By: _____
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Attorneys for Opposer

CERTIFICATE OF ELECTRONIC FILING

I hereby certify that a copy of the attached Opposer's First Amended Notice Of Opposition was electronically filed with the Trademark Trial and Appeal Board's Electronic System for Trademark Trials and Appeals, "ESTTA," on the date shown below:

Dated: January 9, 2008

CERTIFICATE OF SERVICE

I hereby certify that a copy of the attached Opposer's First Amended Notice Of Opposition was served on counsel for Applicant via United States Postal Service First Class Mail, postage prepaid, on the date indicated below to the following address:

Bruce G. Chapman
Connolly Bove Lodge & Hutz LLP
Wells Fargo Center
South Tower, Suite 2300
333 South Grand Avenue
Los Angeles, CA 90071

Dated: January 9, 2008
